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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/994,526  | 11/27/2001  | Akira Tsubouchi      | 18733/00070         | 8523             |
| 24731   | 7590        | 10/16/2003           | EXAMINER            |                  |
| SIDLEY AUSTIN BROWN & WOOD LLP<br>717 NORTH HARWOOD<br>SUITE 3400<br>DALLAS, TX 75201 |             |                      | KRAMER, DEVON C     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3683                |                  |

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                            |                     |  |
|------------------------------|----------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>     | <b>Applicant(s)</b> |  |
|                              | 09/994,526                 | TSUBOUCHI ET AL.    |  |
|                              | Examiner<br>Devon C Kramer | Art Unit<br>3683    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 August 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) 7 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-6 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.

4) Interview Summary (PTO-413) Paper No(s)  
 5) Notice of Informal Patent Application (PTO-1449) Paper No(s)  
 6) Other: \_\_\_\_\_

CHRISTOPHER P. SCHWARTZ  
 PRIMAVERA T. LAMINER

## **DETAILED ACTION**

1) The amendment states on page 5, that claims 8-14 have been added to the application. Claims 8-14 were not presented in the amendment, and a phone call was placed to the attorney of record. It was explained that this was an error in the text of the amendment and that claims 1-7 are the only claims pending in the application.

### ***Claim Rejections - 35 USC § 102***

2) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3) Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Holka (5082077).

Holka provides a rack shaft (32) for a steering system having: two rack teeth groups (116, 118) respectively formed by plastic working and located longitudinally apart from each other; where the rack teeth groups are out of phase by an angle around the axis of the shaft (figure 9).

### ***Claim Rejections - 35 USC § 103***

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holka (5082077) in view of Anderson et al (4741191).

Holka is silent to how the teeth are formed.

Anderson et al teaches forming rack teeth by die forming.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the teeth of Holka with a die as taught by Anderson et al merely to provide an inexpensive, commonly practiced method of forming the teeth. It would have been obvious to either form the teeth either sequentially or simultaneously depending on the die used, equipment available, and the time available for production.

#### ***Response to Arguments***

6) Applicant's arguments filed August 11, 2003 have been fully considered but they are not persuasive.

Applicant argues that Holka fails to disclose two sets of rack teeth groups being "longitudinally spaced apart". Please note that claim 1 states, "located longitudinally apart from each other". The term "spaced" is not present in the claim. Further, Holka does provide rack teeth groups that are longitudinally apart, it depends on from which portions of the teeth groups you look at.

In response to applicant's arguments, the recitation of a hollow rack shaft has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending

from completeness upon the introductory clause. Kropa V. Robie, 88USPQ 478 (CCPA 1951)

Applicant argues that the combination of Holka and Anderson et al is improper. Please note that Anderson is used as a teaching reference of a method of forming metal parts. Using a die to form teeth on elongated metal structures is commonly known in a wide variety of arts.

***Conclusion***

**7) THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3519 for regular communications and 703-308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1134.

DK  
October 7, 2003

CHRISTOPHER P. SCHOBEL  
PRIMARY EXAMINER  
*[Handwritten signature of Christopher P. Schobel]*